



Attorney Docket No.: 224797US36

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

THE SERVICEMASTER COMPANY,

Opposer,

v.

UGI HVAC ENTERPRISES, INC.,

Applicant.

) Opposition No.: 125,743

) Appln. Serial No. 76/237,328

) Opposition No.: 152,104

) Appln. Serial No. 76/166,568

) Cancellation No. 92/041,147

) Registration No. 2,591,190

) Serial No: 76237458



OPPOSER'S RESPONSE TO APPLICANT/RESPONDENT'S
MOTION TO COMPEL DISCOVERY RESPONSES

11-23-2004

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #66

Opposer, The ServiceMaster Company, by counsel, submits this Response to Applicant/Respondent's Motion to Compel Discovery Responses.

I.
INTRODUCTION AND BACKGROUND

In its Motion to Compel Discovery Responses, Applicant/Respondent UGI HVAC Enterprises, Inc. ("Applicant") identifies eight Requests for Production and eight Interrogatories that it contends Opposer has failed to answer adequately. It is Opposer's position that each of the interrogatories and requests has been fully addressed, in the form of written responses and through the production of 1200 pages of responsive documents.

To the extent that Opposer's responses were originally less than one hundred percent complete, Opposer has recently responded with additional documents located since the date of its original written discovery responses and, in some cases, since the date that Applicant's Motion to Compel Discovery Responses was filed. Opposer continued its investigation into the possible

existence of additional documents that just recently came to light during the deposition of its Chief Marketing Officer, Mitchell T. Engel, on November 10, 2004.¹ Additional documents that may be responsive to Applicant's discovery requests will be produced supplementally.

As for certain materials to which Applicant contends it is entitled regarding Opposer's related companies' use of the ARS/RESCUE ROOTER and AMS marks, these materials have not been produced, except when co-branded with the SERVICEMASTER mark, on the basis of Opposer's valid objections on relevance grounds. The use of ARS/RESCUE ROOTER and AMS, per se, by Opposer's related companies is not at issue in this proceeding. Opposer also maintains its stated objections to a handful of Applicant's discovery requests on the basis that they are overly broad, unduly burdensome, and beyond the scope of discovery, particularly given the size and history of Opposer's business.

II.

OPPOSER'S RESPONSES TO APPLICANT'S DISCOVERY REQUESTS

Applicant's First Set of Interrogatories

Applicant has objected to Opposer's answer to a single interrogatory included in its first set of twenty-one interrogatories. Interrogatory No. 11 seeks the identification of "all packaging, containers, tags, labels, flyers, advertisements, catalogs, brochures, decals, imprints and any other goods or materials bearing the SERVICEMASTER marks or used in connection with the SERVICEMASTER marks."

Opposer properly objected to Interrogatory No. 11 on the basis of overbreadth based on the wording "any and all packaging . . . bearing the SERVICEMASTER marks" (emphasis added). However, Opposer agreed to produce, and has produced, a representative sampling of the materials requested. The production of a representative sampling is appropriate because

¹ Opposer notes Applicant's refusal to grant a short extension of time to respond to the instant Motion in order to adequately investigate the existence of additional relevant materials.

compliance with a request to identify any and all such items would be unduly burdensome given the extent of consumer services Opposer has offered during its business history that spans a period of over fifty years.

The responsive documents that Opposer has produced to date include: **brochures** (SVM0380-SVM0385 Brochure: "ServiceMaster Facilities Management" Brochure; SVM0386-SVM0387 Brochure: "ServiceMaster Plant Operations & Maintenance Services" Brochure; SVM0388-SVM0389 Brochure: "ServiceMaster Facility Operations and Maintenance" Brochure; SVM0390-SVM0393 Brochure: "ARS ServiceMaster Join the Winning Team" Brochure; SVM0394-SVM0397 Brochure: "ARS ServiceMaster Come Lead with Us" Brochure; SVM0398-SVM0399 Brochure: "Halliwell Building Commissioning Services: Scope of Work" Brochure; SVM0400-SVM0523 Brochure: "Aramark ServiceMaster Halliwell Engineering Associates, LLC Qualifications & Experience" Brochure; SVM0524-SVM0696 Presentation/Brochure: "ServiceMaster Engineering Services Presented to Aramark Nov. 19-20, 2001"; SVM1047-SVM1055 Brochure: "How Do You Keep Your Home Looking and Feeling Its Best? – ServiceMaster Family of Brands"), **advertisements** (SVM00697 Advertisement: Sample Direct Mail Piece for Plumbing Services; SVM00698 Advertisement: Sample Direct Mail Piece for HVAC Services; SVM00699 Advertisement: Sample Direct Mail Piece for Plumbing Services; SVM00700 Advertisement: Sample Direct Mail Piece for Plumbing Services; SVM00955-SVM00962 Advertisement: Sample Mailers for Rescue Rooter and Service Express; SVM01020-SVM1046 Advertisement: Mailers for ServiceMaster Home Center; SVM01056-SVM01057 Advertisement: Coupon ServiceMaster Home Service Center 10% off any service up to \$150 off; SVM01058-SVM01059 Advertisement: Glossy Circular "Give the Gift of Time"; SVM01060-SVM01061 Advertisement: "Give Your Employees the Gift of Time"; SVM01062-SVM1069 Advertisement: "Bringing more top-name services to the

place you call home”; SVM01070-SVM01077 Presentation: “The Gift of Time” Gift Certificates Q & A: Corporate Program”), and **Internet web site print outs** (SVM00701-SVM00730 Web Site Print-Outs: Pages from www.servicemaster.com; SVM00731-SVM00749 Web Site Print-Outs: Pages from www.ars.com; SVM00750-SVM00762 Web Site Print-Outs: Pages from www.amsofusa.com; SVM0216-SVM022 Web Site Print-Outs: Pages from servicemaster.com web site showing various services offered by The ServiceMaster Company).

These documents are directly responsive to Applicant’s Interrogatory No. 11 and were produced in response thereto pursuant to Rule 33(d), Fed. R. Civ. P. A search for additional relevant documents is underway and additional documents will be produced should they be located.

In addition, Opposer has responded to Applicant’s interrogatories with written responses describing the manner and extent of use of Opposer’s SERVICEMASTER marks, including the use of Opposer’s SERVICEMASTER marks in connection with HVAC and plumbing services. *See* Answers to Applicant’s Second Set of Interrogatories No. 1, 2, 3, 4, 5, 8, and 12, and Answers to Applicant’s First Set of Interrogatories 2(a),(b), 6, 7, 8, 11, and 18.

Applicant’s Requests for Production of Documents

For the Board’s convenience, Opposer sets forth each of the Requests for Production identified by Applicant in its Motion to Compel Discovery Responses and the documents that Opposer now has produced in response to each of the requests.

| NO | REQUEST | DOCUMENTS PRODUCED |
|----|---|--|
| 4 | Produce all documents and things concerning any plans, schedules, or programs for marketing, advertising, or promoting any goods or services offered for sale or sold or intended to be offered for sale or sold under the SERVICEMASTER marks. | <p>SVM01078-SVM01108 Study: Driving Growth Through Enhances Customer Relationships (September 20, 2000).</p> <p>SVM01109-SVM01134 Study: Improving the Value of the Consumer Services Business (May 4, 2001).</p> <p>SVM01135-SVM01159 Study: Capturing the Business Support Services Opportunity (January 16, 2002).</p> <p>SVM01160-SVM01190 Study: Valuation of Various Trademarks of the ServiceMaster Company as of April 30, 2003 (redacted).</p> |
| 7 | Produce all documents and things that identify the persons who purchase, or to whom are offered for purchase, any goods or services under the SERVICEMASTER marks. | <p>In addition to the brochures, advertisements, web page materials, and studies outlined above, Opposer produced the following brochure, example of third-party media attention, and annual reports for 1998 - 2003:</p> <p>SVM0230-SVM0237 Brochure: "The ServiceMaster Consumer Services Chronicle" (with ServiceMaster profiles) showing International Operations and Describing Various Services.</p> <p>SVM0238-SVM0330 Annual Reports: "The ServiceMaster Company Annual Reports for 1998-2000".</p> <p>SVM0331 Article: Article from The Wall Street Journal E-Business pages dated 06-04-01 describing The ServiceMaster Company's role in the home services industry and establishment of weservehomes.com.</p> <p>SVM00763-A-SVM00954 Annual Reports: ServiceMaster Annual Reports for 1998-2003.</p> |
| 8 | Produce all documents concerning any communications that Opposer had (whether orally or in writing) with any other person or persons regarding the SERVICEMASTER marks or another party's right to use these marks, or any mark the Opposer considered as or alleged to be confusingly similar thereto. | <p>SVM0332-SVM0341 Correspondence: Correspondence with licensees regarding termination of franchise and ServiceMaster's exclusive rights to use the SERVICEMASTER mark.</p> <p>SVM0195-SVM0215 Agreement: ServiceMaster Franchise Agreement.</p> |

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| 14 | Produce all documents and things which support Opposer's assertions that the public is likely to be confused, mistaken, or deceived thereby, by the coexistence of the Applicant's marks and Opposer's marks. | See brochures, advertisements, web site materials, third-party media attention, annual reports, and studies listed above. |
| 17 | Produce all documents which support Opposer's assertions that the SERVICEMASTER mark has achieved the status of a famous mark. | See brochures, advertisements, web site materials, third-party media attention, annual reports, and studies listed above. |
| 18 | Produce all documents and things which support Opposer's assertions that the SERVICEMASTER mark has or is likely to become diluted. | <p>In addition to the brochures, advertisements, web site materials, third-party media attention, annual reports, and studies listed above, Opposer produced the following responsive documents:</p> <p>SVM0001-SVM0181 Manual: "ServiceMaster Residential/Commercial Services Identity Manual".</p> <p>SVM0342-SVM0343 <i>Official Gazette</i>: "Pages from the 12-25-01 <i>Official Gazette</i> showing publication of application for SERVICEMARK, 76/166,568".</p> <p>SVM0344-SVM0346 USPTO Print-Outs: "Print-outs from USPTO web site showing status of SERVICEMARK applications".</p> <p>SVM01191-SVM01200 Manual: "ServiceMaster Company/ServiceMaster Brand Usage Guidelines".</p> |
| 19 | Produce all other documents and things which Opposer contends supports any element of its Notice of Opposition. | Opposer will rely on the brochures, advertisements, web site materials, third-party media attention, annual reports, and studies, USPTO information, <i>Official Gazette</i> information, and services identity manuals listed above. |

Applicant's Second Request for Production of Documents

| NO. | REQUEST | DOCUMENTS PRODUCED |
|-----|---|---|
| 6 | Produce all documents which relate to, refer to, reflect, or evidence any inquiry, investigation, evaluation, analysis, or survey conducted by Opposer or any person acting for or on behalf of Opposer regarding any issues involved in the pending TTAB proceeding involving The ServiceMaster Company and UGI HVAC | <p>SVM01078-SVM01108 Study: Driving Growth Through Enhances Customer Relationships (September 20, 2000).</p> <p>SVM01109-SVM01134 Study: Improving the Value of the Consumer Services Business (May 4, 2001).</p> |

| | | |
|--|-------------------|---|
| | Enterprises, Inc. | <p>SVM01135-SVM01159 Study: Capturing the Business Support Services Opportunity (January 16, 2002).</p> <p>SVM01160-SVM01190 Study: Valuation of Various Trademarks of the ServiceMaster Company as of April 30, 2003 (redacted).</p> |
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Opposer's Production Relating to Studies, Surveys, Etc.

Applicant decries what it describes as Opposer's "wholesale failure to produce documents" relating to inquiries, surveys, evaluations, polls and studies, and relies on what it believes are revealing public statements by Opposer's Chairman and Chief Executive Officer, Jonathan P. Ward.

Opposer produced four "studies", which it maintains are largely irrelevant to the core of these proceedings, on November 23, 2004. Although the relevance of these studies is questionable at best, Opposer hopes to satisfy the curiosity of Applicant in willingly providing these internally prepared "attorneys-eyes-only" corporate documents.

Opposer's continued investigation into documents to locate "surveys, investigations, and/or research conducted by or on behalf [sic] Opposer related to the strength, market penetration, strategy, or use of Opposer's Mark" very recently has yielded the following additional potentially responsive materials that will be provided in the next seven to ten days: Category Home Services Brand Study and related documents, CFI Group Voice of the Customer Program Findings and Recommendations and Final Report, and Branding Initiative and Brand Positioning Study.

Opposer's Objections Based on Overbreadth

Opposer restates its previous objection to the above requests, and specifically takes issue with Document Request Nos. 14, 17, 18, and 19 (First Set) which ask that Opposer produce all

evidence in support of the Section 2(d) and trademark dilution claims asserted in its Notices of Opposition and Petition for Cancellation. Opposer is not required to set forth in detail all evidence it intends to presents in support of its claims during discovery. *See Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1657 (TTAB 2002)(interrogatory requesting that opposer “identify each and every fact, document and witness in support of its pleaded allegations” was equivalent to a request for identification of fact witnesses and trial evidence prior to trial, and therefore improper). Opposer’s current and intended future production in response to these requests is sufficient and Applicant’s motion to compel further responses is misplaced.

Applicant’s Second Set of Interrogatories

Applicant objects to Opposer’s answers to Interrogatory Nos. 2, 3, 4, 5, and 7.

Applicant’s Interrogatory Nos. 2 through 5 seek specific information regarding (1) Opposer’s residential HVAC and/or plumbing services and/or related goods (Interrogatory No. 2), (2) Opposer’s commercial HVAC and/or plumbing services and/or related goods (interrogatory No. 3), (3) any **related party’s** residential HVAC and/or plumbing services and/or related goods (Interrogatory No. 4), and (4) any **related party’s** commercial HVAC and/or plumbing services (Interrogatory No. 5).²

² Subparts of each interrogatory request the following information:

- (a) the full business address of each U.S. location;
- (b) the date(s) on which business commenced and, if applicable, terminated, as to each service and/or offer for sale of goods;
- (c) the particular service(s) and/or particular good(s) on or in connection with which Opposer’s Mark has been used, and the periods of time during which Opposer’s Mark was used on or in connection with each particular service and/or good;
- (d) the particular color(s) in connection with which Opposer’s Mark has been used, and the periods of time during which Opposer has used such color(s) in connection with Opposer’s Mark;
- (e) the Mark(s) (other than Opposer’s Mark) used on or in connection with the services and goods, indicating as to each the particular service and/or good on or in connection with which the Mark has been used, and the periods of time during which the Mark was used on or in connection with the particular services and/or good.

Opposer has responded in full to these interrogatories to the extent that it believes that they are relevant, including providing both general information about the use of SERVICEMASTER by The ServiceMaster Company and its related companies, *see* Opposer's Answers to Interrogatory Nos. 2(a), (b) (First Set), and in providing specific addresses of individual ServiceMaster locations, *see* Opposer's Answer to Interrogatory No. 2 (Second Set), as well as producing a list of AMS and ARS/Rescue Rooter locations using the SERVICEMASTER mark (SVM00963-SVM00966 List: List of AMS, and ARS/Rescue Rooter Locations).

Opposer maintains its objection that the ARS/RESCUE ROOTER and AMS marks, used by Opposer's related companies without the SERVICEMASTER mark, are not at issue in this proceeding. Therefore, inquiries regarding the extent of use, or non-use, of the ARS/RESCUE ROOTER and AMS marks, are beyond the scope of the pleadings, are irrelevant to claims or defenses of any party in this proceeding, and are not reasonably calculated to lead to the discovery of admissible evidence under the Federal Rules of Civil Procedure and Trademark Rules of Practice. *See* TBMP § 414(11) and *Volkswagenwerk Aktiengesellschaft v. Thermo-Chem Corp.*, 176 USPQ 493, 493 (TTAB 1973). The Definitions and Instructions included in Applicant's own discovery requests define "Opposer's Mark" as the marks of "Registration Nos. 1,220,269 and 1,272,228, and the corresponding common law rights afforded by use thereof as asserted by Opposer in Count I of [Opposer's] Notice of Opposition." *See* Definitions and Instructions sections of Applicant/Respondent's Second Set of Interrogatories to Opposer/Petitioner and Applicant/Respondent's Second Request for Production of Documents and Things. Opposer relies on rights in SERVICEMASTER to support its claims. Applicant's discovery is not relevant to the extent that it calls for documents relating to marks used by

Opposer's related companies ARS/Rescue Rooter and AMS other than SERVICEMASTER, because these marks are not asserted against Applicant in these proceedings.

Opposer has consistently offered plumbing and HVAC services under the SERVICEMASTER mark since before Applicant adopted, filed for federal registration, or used its SERVICEMARK marks in commerce. Opposer relies on its incontestable registrations in this matter and therefore priority of use is not an issue. *King Candy Company v. Eunice King's Kitchen*, 182 USPQ 108, 111 (C.C.P.A. 1974). Moreover, Opposer has produced information and documents that support the use of its SERVICEMASTER marks in connection with HVAC and plumbing services. These include uses of SERVICEMASTER by related companies ARS/Rescue Rooter and AMS. Opposer has also produced a Rule 30(b)(6) witness that explained during the course of his discovery deposition, the history of use of the SERVICEMASTER mark, including use in commerce by Opposer and its related companies in connection with HVAC and plumbing services.

Applicant relies on the fact that certain HVAC and plumbing dealers associated with Opposer continue to use their own marks in connection with HVAC and plumbing services as evidence that Opposer does not have rights in the SERVICEMASTER marks for these services. The law is well settled that a service or product may be marketed under more than one trademark. *See Carter-Wallace, Inc. v. Procter & Gamble Co.*, 167 USPQ 713, 717 (9th Cir. 1970); *Old Dutch Foods, Inc. v. Dan Dee Pretzel & Potato Chip Co.*, 177 USPQ 496, 498-99 (6th Cir. 1973). As long as the public recognizes the mark as a mark it is protectible no matter how many other marks appear in addition. *See America Distilling Co. v. Bellows & Co.*, 88 USPQ 259 (1951). Secondly, the nature of HVAC and plumbing businesses is such that contractors continue, for a time, to use historical trade names in certain forms of advertising. The fact that

ARS and AMS may use the ARS/RESCUE ROOTER and AMS marks in addition, does not make uses of ARS/RESCUE ROOTER or AMS alone relevant.

Applicant's Interrogatory No. 7 seeking written policies regarding the use of Opposer's marks in connection with HVAC and plumbing services,³ was fully responded to. *See* Answer to Interrogatory No. 5 (First Set) and documents: SVM0001-SVM0181 Manual: "ServiceMaster Residential/Commercial Services Identity Manual"; SVM00967-SVM00978 License: Trademark License Agreement between The ServiceMaster Company and ServiceMaster Management Services Limited Partnership dated November 30, 2001; SVM00979-SVM00997 License: Trademark License Agreement between ServiceMaster Brands LLC and American Mechanical Services Company LLC dated April 30, 2003; SVM00998-SVM01018 License: Trademark License Agreement between ServiceMaster Brands LLC and American Residential Services Holding LLC dated April 30, 2003; and SVM0195-SVM0215 Agreement: ServiceMaster Franchise Agreement; and SVM01191-SVM01200 Manual: ServiceMaster Company/ServiceMaster Brand Usage Guidelines. Opposer's further investigation into materials responsive to Interrogatory No. 7 has yielded no additional documents.

III. CONCLUSION

The information and documents Applicant has requested have been produced and supplemented. To the extent there are additional responsive documents very recently located by Opposer, these documents will be produced in the near future.


³ Interrogatory No. 7 reads: State any policy (written or unwritten) and identifying and locate any documents, concerning any and all uses of each of the Marks (other than Opposer's Marks) used on or in connection with the provision of any HVAC and/or plumbing services and/or related products by, for, or on behalf of, Opposer and any Related Party.

Accordingly, Opposer respectfully requests that Applicant's Motion to Compel Discovery be denied.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **OPPOSER'S RESPONSE TO APPLICANT/RESPONDENT'S MOTION TO COMPEL DISCOVERY RESPONSES** was served on counsel for Applicant, this 23rd day of November, 2004, by sending same via First Class mail, postage prepaid, to:

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